Remarks/ Arguments

This application currently includes claims 36-38 and 50-73. Applicant respectfully reiterates the following remarks and arguments, which are based on arguments submitted with the April 28, 2005 amendment in this case, and relate to claims rejected in the January 28, 2005 Office Action in this case.

New claim 73 (based on former claim16) is submitted in response to the Examiner's comments regarding claim 16 on page 3 of the January 2005 Office Action, in order to clarify that the 'predetermined address' cannot be selected, or modified, by the user. Applicant believes that this claim limitation was inherent in the fact that the address was predetermined, but has added this clarifying language in claim 73 in an effort to remove any prior ambiguity and put this claim in allowable form.

Claims 59, 73, 68 and 72 are based respectively on former claims 9, 16, 29 and 33 which were rejected under 35 U.S.C. 102(e) as anticipated by Ward et al. (U.S. 2003/0142215 A1). Applicant respectfully traverses the rejection.

The Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §2131, specifies that a given claim is anticipated "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed.Cir.1987). Moreover, MPEP §2131 indicates that the cited reference must show the "identical invention... in as complete detail as is contained in the... claim," citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the Examiner has failed to establish anticipation of current claims 59, 73, 68 or 72 by the Ward reference.

Ward is directed to a configuration file on a digital camera which contains information for transmitting images to a selected destination service (which Ward discloses may be an online service (ISP) or a digital photofinishing center (see

abstract) and that "Multiple sets of **destination services** can be stored on the memory card 30." (see Ward paragraph 13)). Thus Ward discloses in paragraph 4 a configuration file that is created outside the digital camera "at a host computer and downloaded to a digital camera. This file contains instruction information for communicating with a selected **destination** via a communications interface".

Applicant reiterates his position that independent claim 59 (formerly claim 9) distinguishes over Ward at least by reciting two elements (a) "a memory ... that contains... an address associated with a remote server" and (b) "user interface means ... for at least displaying a list of recipient codes stored in said configuration table and receiving signals indicating user selection of at least one recipient code", and "processor control means, responsive to signals received from said user interface means, for transmitting one or more messages including at least one recipient code to said remote server". Applicant submits again that Ward's configuration files shown in figures 4A and 4B show a phone number but no address for a destination server, and therefore Ward does not disclose a connection directly to a server at a particular address, "in as complete detail as is contained in the claim" i.e. claim 59.

Examiner rejects this analysis regarding presence of an address, and goes on to say the utilization file would normally contain an e-mail address of the recipient in the memory 28/30 of the camera, and further states his understanding that when Ward discloses a "list of images to be e-mailed to various recipients, is written into the "utilization" file", this means a list of email addresses is written into the utilization file. Applicant respectfully submits that this is an incorrect interpretation of this sentence. What it discloses is nothing more than that a list of images... is written into the utilization file. Not, that this utilization file also contains email addresses, which are analogous to the recipient codes of claim 59. Applicant requests that the Examiner carefully reconsider this point, and consider whether it could be interpreted differently, that is, it means the list of images is intended to be emailed, but not necessarily that the list includes email addresses. To reach this conclusion, one must know what is

disclosed in Parulski about the utilization file, but this information is not in the Ward disclosure, which Applicant contents only says that a list of images is in the utilization file. Therefore, Ward fails to anticipate claim 59 under the MPEP §2131 requirements because Ward only discloses a configuration file that contains information for contacting the ISP, and a list of images in a utilization file, but it does not disclose a server address and one or more recipient codes as in claim 59. Accordingly, Applicant respectfully submits that the invention of Claims 59 and dependent claim 60 are not anticipated by Ward.

New claim 73 is based on former claim 16 but is modified to respond to the Examiner's earlier comments, in order to clarify that the 'predetermined address' cannot be selected, or modified, by the user. Applicant believes that this claim limitation was inherent in the prior claim 16, where the address was predetermined, but has modified this language in an effort to remove any prior ambiguity and put this claim in allowable form.

Applicant continues to hold the view that Claim 73 distinguishes over Ward, because the method of Claim 73 is directed to transmitting a message to a remote system associated with an address that cannot be modified or selected by the user and is therefore a predetermined address. Conversely, the primary feature of Ward's disclosed method involves a step where the user selects a destination service icon. The Ward configuration file "contains instruction information for communicating with a **selected destination** via a communications interface." Thus Ward discloses a method which uses the selected destination service icon to retrieve associated data (instruction information) in the configuration file in order to connect to a corresponding destination service. Ward teaches that this destination service is one of a plurality of choices available to the user; accordingly Ward does not disclose the method of present claim 73 which transmits a message to a remote system associated with a predetermined address which is not user-selected. Consequently, the claim 73 address and remote system are always the same, regardless of what recipient code is selected, and in Claim 73 there is no selection (as in Ward) of a

destination service.

Applicant also submits that as previously stated in relation to Claim 59, the utilization file as disclosed by Ward does not contain information that is analogous to the recipient code element of Claim 73.

For these reasons, Applicant submits that the method of Claim 73 is patentably distinct from the method of Ward, and is in condition for allowance.

Applicant reiterates his view that claim 68 (former claim 29) distinguishes over Ward at least because it discloses a method that recites a first user input for selecting a recipient representation and recites a second user input, and then three things happen in response to each second user input (image is captured, message including image is formatted, and message is transmitted). Applicant understands the Ward disclosure of Figure 2 differently from Examiner, and can find nothing in Ward that could reasonably be interpreted as disclosing that the images are captured (step 50) not after, but *prior to*, the send button request (step 58). Applicant submits that claim 68 is intended to say that the above three steps d)1, d)2 and d)3 occur automatically after the second input, and without any intervening input. If 'activating the camera for a second time" is considered the second input, then Ward still shows that taking the image (step 50) occurs before pressing the send key (step 52). Applicants understands Ward to say that step 58 is not when the send key is pressed, but rather represents a logic step to evaluate whether the send key (step 52) was previously pressed (see paragraph 14: "this is done by choosing one of the keywords"). Thus, the timing of steps in the method of claim 68 is patentably distinguishable over the method disclosed by Ward, and Claim 68 is allowable over Ward, where the image is always taken (or displayed) before the send key is selected.

Independent claim 72 (former claim 33) distinguishes over Ward at least by reciting a distribution mechanism that is patentably distinct from the distribution mechanism described by Ward. In particular, Ward does not store data corresponding to a selected recipient, and then distribute this data, with the

next image formed by the digital camera, to a networked computing device. Applicant respectfully submits that Examiner is incorrect in the Jan. 28, 2005 Office Action where he states on page 4 that send is selected in step 58. Rather, Applicant submits that Ward discloses, as discussed above, that the decision to transmit one or more images (the 'send' decision) is made at step 52. And, per Ward paragraph 15 at step 58 "the system determines whether a request exists to send an image". Rather step 52, selection of an icon, is disclosed as the send decision, and this is always after images are captured. Accordingly, in Ward recipient data is not automatically transmitted as in claim 72 "with the next image formed".

Claims 62, 63, 64, 65 and 66 correspond to claims 21, 23, 24, 25, and 26 which were rejected under 35 U.S.C. 102(e) as anticipated by Parulski et al. (U.S. 2003/0025808 A1). Parulski discloses a utilization file that allows the user to "select 'downstream' services at the time of capture" and create print/ transmission/ albuming orders on a camera.

Applicant submits that Claim 62 distinguishes over Parulski '808 at least by reciting "transmitting a message including at least one digital image and at least one code to a predefined remote server".

However, assuming for the sake of argument that the utilization file does contain an address of the server, Applicant submits that Claim 62 distinguishes over Parulski by reciting "parsing the message at the server and processing each image according to each code"; Parulski discloses no such activity. Accordingly, Applicant submits that Claim 62 is allowable over Parulski.

Claims 63 and 64 depend from Claim 62 and Applicant respectfully submits that these are patentable over Parulski for at least the same reasons that Claim 62 is patentable over Parulski.

Applicant submits that Claim 63 further distinguishes over Parulski '808 at least by reciting additional **server** processing steps that are not disclosed by Parulski. Namely, "selecting... one set of recipients corresponding to said code to whom said at least one image is to be sent, each set including at least one

recipient" represents a processing step that occurs on the server, not the camera device, and is not disclosed by Parulski. Applicant submits that this step as disclosed, and recited in Claim 63, further serves to make the invention of Claim 63 allowable over Parulski. Similarly, Applicant finds nothing in Parulski that is analogous to the account id of Claim 64. Applicant does not understand Examiner's logic that the code could represent both a recipient and an account identifier, where in Claim 64 these are two distinct elements, and arguably only one or the other is present in Parulski. Accordingly per requirements of MPEP 2131 claim 64 is not anticipated by Parulski.

Independent Claim 65 distinguishes over Parulski by defining a method for transferring information within an image file name, as disclosed where the present disclosure says "an image file may be assigned a unique file name, including the account ID, recipient code, and an image identifier, for later transfer via FTP Put command to the server 140." Applicant can find no such disclosure in Parulski. In Claim 65 essentially all that is transferred to the server is an image file, with a unique file name where such file name itself includes coded information, and respectfully submits that Claim 65 is allowable over Parulski. The Examiner notes on page 5 of the Jan. 28, 2005 office action that 'the features upon which applicant relies (i.e. ... file name...") are not recited in the rejected claims. Applicant respectfully requests that the Examiner re-read these claims, which clearly indicate the image file is captured and saved "with a file name including at least one code". Accordingly this element is present and Applicant does not understand the basis for this continuing rejection.

Claim 66 depends from Claim 65 and Applicant respectfully submits that this Claim is patentable over Parulski for at least the same reasons that Claim 65 is patentable over Parulski.

Claim 69 (former claim 30) is patentably distinct over Enomoto because the Enomoto process is initiated by a user input, while the process of claim 69 is initiated by an event that is not necessarily started by a user input to the system,

the receipt of a digital image. See Col. 6, lines 23-25, and col. 7, lines 14-22. Further, step c) of claim 69 "processing... according to data that is associated on said remote server with the code in the message" is not disclosed by Enomoto. For these reasons Applicant submits that Claim 69 is not anticipated by Enomoto.

Claim 70 depends from Claim 69 and Applicant respectfully submits that it is are patentable over Enomoto for the same reasons that Claim 69 is patentable over Enomoto.

Independent Claim 71 corresponds to claim 32 which was previously rejected under 35 U.S.C. 102(e) as being anticipated by Squilla et al. (U.S. 6,396,537). Applicant submits that the method of Claim 71 is patentably distinguishable over Squilla because in the method of Claim 71, both a user ID and user preference data are established on the server, and only user preference data is transferred from the server to the rental device in order to update the rental device. However, Squilla never discloses or teaches that it would be beneficial to transfer preference/personality data from the server to the rental device. Rather, Squilla teaches transferring personality data in the opposite direction – from the camera to the site – and the site uses this personality data to select "content data" related to the site that would likely be of interest to the user, and either store this content data with the image on the server, or transfer the content (not personality) data back to the camera.

Applicant understands Squilla to disclose that the personality file 52 in device 24/26 would merely store a personal identifier that uniquely relates the camera to the personality file 96 in the server.

Accordingly Applicant submits that the method of Claim 71 is distinct from Squilla due to transfer of the user preference data to the rental device in Claim 71, and Claim 71 is therefore allowable over Squilla.

Current claims 52 – 58 correspond to claims 1-6 and 8 which were rejected under 35 U.S.C. 103(a) as being unpatentable over Safai '469 in view of Korpela et al. (U.S. 6,167,283). Applicant respectfully traverses this rejection.

Claim 52 should be allowable over Safai in view of Korpela because it recites steps of capturing, formatting and transmitting each image in response to a single user input. Claim 52 recites processor control means for "in response to a signal from said user interface, 1) capturing a digital image, 2) formatting a message including at least one said digital image, and 3) transmitting each said message to said remote server via said external network" which Applicant submits is not disclosed in either Safai or Korpela.

In the January 28, 2005 office action the Examiner reiterated his belief that one skilled in the art at the time the invention was made would have been prompted to combine Safi with Korpela to result in the invention of Claim 52. Applicant submits that the relevant art is that of digital photography (method in a digital camera apparatus). Applicant finds nothing in Safai that teaches or suggests that it would be of value in some way or improve the Safai disclosure to combine it with Korpela. There is no teaching in Safai, or knowledge generally available to one of *ordinary skill in the art of digital photography* at the time of the present invention that would suggest this feature could be valuable. It is easy now, with the clarity of hindsight, to see that a persistent wireless link might be desirable, but in 1998, most cellular communications were analog and usage was charged by the minute, at a farily high rate, which expense tended to minimize the desirability of cellular data transmissions. In fact, the Safai reference to settings included in the configuration file (serial port baud rate, parity, and stop bits,) indicates to Applicant that Safai clearly contemplated establishing an analog modem connection, and if any cellular connection was to be established, then it was likely anyone moving from one cell to another would might have their call dropped and have to re-initiate the call. Now, in hindsight, when everyone and their sister has a digital phone, and wifi ads are everywhere, the value of a persistent connection is generally known to those skilled in the art

of digital photography. But applicant submits that that was not the case at the time of the present invention, and only those with extraordinary knowledge in the non-analogous art of cellular technology such as Korpela were aware that a persistent wireless connection could be desirable.

Although CDPD was capable of providing a persistent wireless connection and was available at the time, it was a new technology and was only available in isolated areas, and other wireless data services of today were not yet available or generally known. There was no suggestion or motivation, in Safai, or in the understandings, expectations and knowledge generally available to those of ordinary skill in the art of digital imaging at the time of the invention, to modify Safi, or combine Safai with Korpela in order to arrive at the present invention of Claim 52, and to do so now is nothing more than hindsight reconstruction. Applicant submits again, Claim 52 should be allowed over these references.

Safai '469 is directed to a digital camera that includes means for entering an email address and transmitting digital images to that address. Korpela '283 is directed to a method in a cellular terminal for selecting a particular cell base station with which to establish a communication connection, based either on a user profile in the terminal memory or based on user selection of what type communication is to be conducted.

In order to establish obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Applicant is unable to interpret the single Safai reference to "wireless links" as providing any teaching or suggestion that cellular communications were preferable to other communication channels, and certainly this single reference doesn't provide a suggestion or motivation to establish a persistent wireless link, by combining Korpela technology, which is directed to optimizing a cellular network connection, with the Safai digital camera. Further, Applicant submits that the understandings, expectations and knowledge generally available to those of ordinary skill in the art of digital imaging at the time of the present invention taught away from use of cellular transmissions as a

means of communications for digital images or other large data files. In this regard, Applicant notes that Korpela was filed in the US approximately one month prior to the present invention and it seems unlikely the subject matter of the Korpela disclosure was generally known at the time of the present invention in the field of cellular transmissions, and much less likely that it would be known in the art of digital imaging. In fact, Applicant understands that the first high speed "3G" cellular network was commercially launched by NTT DoCoMo in Japan in October 2001. Thus Applicant submits that there was no suggestion or motivation, either in Safai or Korpela, or in the knowledge generally available to one of ordinary skill in the art of digital imaging at the time of the invention, to modify or combine the Safai and Korpela teachings in order to arrive at the present invention, and accordingly the invention of Claim 52 should be allowed over these references.

Claims 53 - 58 depend from Claim 52 and Applicant respectfully submits that these are patentable over Safai in view of Korpela for at least the same reasons that Claim 52 is patentable over Safai in view of Korpela.

Claims 67 corresponds to claim 28 which was rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (US 2003/0142215) in view of Korpela (US 6,167,283). Applicant respectfully traverses these rejections. Applicant traverses the rejection of claim 67 for the reasons given in the September 13, 2004 Amendment in this case, but cancels this claim from the present case in order to bring it to closure.

Independent Claim 68 is directed to a method that corresponds to the apparatus of Claim 52. Examiner reiterates his belief that one skilled in the art at the time the invention was made would have been prompted to combine Ward with Korpela to result in the invention of Claim 67. Applicant submits that the relevant art is that of digital photography (method in a digital camera apparatus). Applicant finds nothing in Ward that teaches or suggests that it would be of

value in some way or improve the Ward disclosure to combine it with Korpela. There is no teaching in Ward, or knowledge generally available to one of *ordinary skill in the art of digital photography* at the time of the present invention that would suggest this feature could be valuable. It is easy now, with the clarity of hindsight, to see that a persistent wireless link might be desirable, but in 1998 cellular usage was generally charged by the minute, at a farily high rate, which expense tended to minimize the desirability of cellular data transmissions. In fact, the Ward reference to settings included in the configuration file (serial port baud rate, parity, and stop bits,) indicates to Applicant that Ward clearly contemplated establishing an analog modem connection; any cellular connection used for this type connection at the time would have been charged by the second, and applicant submits that from a common sense perspective, this would teach away from using a persistent connection. Now, in hindsight, when digital phones are commno, and wifi ads are everywhere, the value of a persistent connection is generally known to those skilled in the art of digital photography. But applicant submits that was not the case at the time of the present invention, and only those with extraordinary knowledge in the non-analogous art of cellular technology such as Korpela might have realized that a persistent wireless could be of value.

There was no suggestion or motivation, in Ward, or in the understandings, expectations and knowledge generally available to those of ordinary skill in the art of digital imaging at the time of the invention, to modify or combine Ward with Korpela teachings in order to arrive at the present invention of Claim 67, and that to do so now is nothing more than hindsight reconstruction. Applicant submits again, Claim 67 should be allowed over these references.

Further, Claim 67 should also be allowable over Ward in view of Korpela because it recites steps of capturing, formatting and transmitting each image in response to a single user input. Claim 67 recites the step of "in response to a signal from said user interface, 1) capturing a digital image, 2) formatting a message including at least one said digital image, and 3) transmitting each said message to said remote server via said external network" is not found in either Ward or Korpela. On the contrary, Ward teaches, in paragraphs 15-18, that "after

the user selects the images to be sent and presses the "send" button, the camera performs the following steps without user intervention:

1) Read the appropriate connection parameters from the network configuration file (on the memory card 30 or internal camera memory 28), dial the phone and establish the connection to the destination service 14.

2) Read the user's account name and password and transmit these to "log-on" to the service 14.

3) Using the appropriate communications protocol (FTP, mailto, etc.), transmit the selected image or images to the destination service 14. "

Applicant does not understand how Ward could be interpreted to disclose any process other than capturing one or more images, selecting one or more images, and then initiating transfer by pressing a send key. Accordingly Applicant submits that Ward teaches the steps that are performed in response to a signal (pressing the send button) do not include "capturing a digital image" as per the method of Claim 67, and this claim limitation alone is sufficient for allowing Claim 67 over Ward in view of Korpela.

Claims 61 corresponds to claim 11 which was rejected under 35 U.S.C 103(a) as being unpatentable over Parulski '808 in view of Ward '215. Applicant respectfully traverses the rejection of Claim 61 as being unpatentable over Parulski '808 in view of Ward '215.

Applicant submits that Claim 61 does not distinguishes over Parulski '808 at least by reciting a "destination address" or "control means for ... transmitting a message including at least said selected recipient code and one said digital image, to said destination address via said RF communications device", neither of which are disclosed by Parulski or Ward.

Applicant further submits that Claim 61 is distinguishable over Parulski in view of Ward because the server control means element "for parsing said recipient code from each said message and processing each said message according to said account configuration data associated with said recipient code"

is not found in Parulski or Ward. Nor do Parulski or Ward disclose account configuration data associated on the server with a recipient code.

For these reasons, Applicant respectfully submits that the invention of Claim 61 is not obvious over Parulski in view of Ward.

Claim 36 was previously allowed. For the reasons explained herein, Applicant respectfully submits that the present Claims 37, 38, and 50-73 are not anticipated by nor obvious over the cited prior art references, and are allowable.

Respectfully submitted,

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